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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,391	05/09/2001	Yoshiaki Moriyama	041465-5111	3429

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EXAMINER

LANIER, BENJAMIN E

ART UNIT PAPER NUMBER

2132

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/851,391

Applicant(s)

MORIYAMA ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 12-14, 19, 22, 25, 27, 28 and 30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 5-7, 12-14, 19, 22, 25, 27, 28 and 30 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed 02 May 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Response to Arguments*

2. Applicant's arguments filed 02 May 2005 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the **language of the claims** patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks **the claims** present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The added material which is not supported by the original disclosure is as follows: wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation “the descramble system applying step applies two types of the descramble system only to a scramble system of the information signal with the first copy control information and a scramble system of the information signal with the second copy control information” which renders the claim vague and indefinite because it is unclear whether

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the descramble system applying step applies two different types of scrambling techniques (i.e. double scrambling) to the information signal with the first or second copy control information or whether it applies only one of the two types of descrambling systems to the information signal with the first or second copy control information. Examiner can find no specific recitation in Applicant's specification that correlates to double scrambling, so for the purposes of examination the limitation will be treated as one of the two types of the descramble systems.

8. Claim 1 recites "descramble system in the recording process is different from that in the reproducing process" which renders the claim vague and indefinite because the recording process and the reproducing process have not been claimed as having a descramble system to this point. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5-7, 12-14, 19, 22, 25, 27, 28, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto, EP 938,091. Referring to claims 1, 5-7, 12-14, 19, 22, 25, 28, Hashimoto discloses an information recording system wherein data is recorded and encrypted, with copy control information, in different modes to allow for varied copy protection. When the data is received the copy control information and encryption mode indicator are read from the data header to determine the copy protection that will implemented during storage. The copy control information indicates "free", "once", or "prohibited" in conformity with the copy

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restriction state of the corresponding data (Col. 8, lines 14-53), which meets the limitation of a discriminating step of discriminating the type of the scramble system of the inputted information signal and the type of the copy control information of the inputted information signal, the copy control information including first copy control information indicating permission to copy the information signal only once and second copy control information indicating prohibition of copying the information signal after the information signal is copied once. The encryption mode indicator (EMI) indicates the encryption mode of the data. More specifically the EMI indicates mode A for copy-prohibited data, mode B for copy once data, or free for non-encrypted copy free contents data (Col. 8, line 54 – Col. 9, line 1), which meets the limitations of a scramble system applying step of applying a predetermined scramble system to the inputted information signal and producing a scrambled output when a combination of the discriminated type of the scramble system and the discriminated type of the copy control information coincides with that included in a selected condition, and wherein the selected condition including combinations of a plurality of types of scramble systems applicable to the information signal and a plurality of types of the copy control information to eliminate copying of the information signal via an unauthorized path, the copy control information including first copy control information indicating permission to copy the information signal only once and second copy control information indicating prohibition of copying the information signal after the information signal is copied once. A decryptor provides decryption of the input data signals (Col. 7, lines 41-44), which meets the limitation of a descramble system applying descramble systems to the inputted information signal. The encrypted signal contains an EMI code in the header that identifies a mode of encryption/decryption that that is used. The EMI codes indicate different modes that

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include copy prohibited mode, copy once mode, and a copy freely mode (Col. 8, line 56 – Col. 9, line 1), which meets the limitation of wherein the descramble system applying step applies two types of the descramble systems only to a scramble system of the information signal with the first copy control information and a scramble system of the information signal with the second copy control information, wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium, wherein in the reproducing process, the scramble system applying step applies three different kinds of scramble systems to the information with the first copy control information recorded on the recording medium, to the information with the second copy information recorded on the recording medium, and to the information signal with the first copy control information outputted from a receiving apparatus. In the case where digital information is recorded on a storage medium in an encryption form using the copy once mode, once the digital information is decrypted, it would be recorded using the copy prohibited mode since the allotted one copy has been made, which meets the limitation of wherein the scramble system in the recording process is different from that in the reproducing process. Similarly decryption of the digital information recorded on a storage medium in an encryption form using the copy once mode would decrypt the digital information using a decryption method compatible with the copy once mode, and decrypt the encrypted information that is later encrypted using copy prohibited mode using a decryption method compatible with copy prohibited mode, which meets the limitation of the descramble system in the recording process is different from that in the reproducing process.

Referring to claims 2, 27, 30, the plurality of encryption modes of Hashimoto (Col. 8, line 54 – Col. 9, line 1) would meet the limitations of a plurality of the scramble systems include scramble processings each having different algorithms and corresponding descramble processings and the different scramble systems based on the copy control information.

Referring to claim 3, the copy control information of Hashimoto (Col. 8, line 26-53) would meet the limitation of scramble processings each having different keys and corresponding descramble processings.

### *Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.



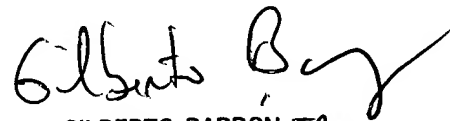
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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